Patent and Trademark Office 37 CFR Parts 1 and 10 [Docket No. 910764-1306] RIN: 0651-AA27

Duty of Disclosure

Agency: Patent and Trademark Office, Commerce

Action: Notice of final rulemaking.

Summary: The Patent and Trademark Office (Office) is amen ing the rules of practice in patent cases to (1) clarify the duty of ing the rules of practice in patent cases to (1) ctarry use duty of disclosure for information required to be submitted to the Office; (2) provide flexible time limits for submitting information disclosure statements including the requirement for a fee in certain cases; (3) eliminate consideration of duty of disclosure issues by the Office except in disciplinary and interference proceeding and under other limited circumstances; and (4) eliminate the striking of patent applications which are improperly executed. The Office further is amending the Patent and Trademark Office Code of Professional Responsibility to define as misconduct a failure to comply with the rules on duty of disclosure. The rules as adopted strike a balance between the need of the Office to obtain and consider all known relevant information pertaining to patentability before a patent is granted and the desire to avoid or minimize unnecessary complications in the enforcement of

Effective Date: March 16, 1992. These rules will be applicable to all applications and reexamination proceedings pending or filed after the effective date.

For Further Information Contact: By telephone Charles E. Van Hom (703-305-9054) or J. Michael Thesz (703-305-9384) or by mail addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231, and marked to the attention of Charles E. Van Horn (Crystal Park 2 - Room 919).

E. van norn (Crysal Park 2 - Room 919). Supplementary Information: A notice of proposed rulemaking on duty of disclosure and practitioner misconduct published in the Federal Register at 54 FR 11334 (March 17, 1989), and in the Patent and Trademark Office Official Gazette at 1101 Off. Gaz. Pietet and Traßemark Office Official Gastete 1110 Off. Gas-Pac Off. 12 (April 1, 1999), was withdrawn. On August 6, 1991, the Office published in the Faderal Register a notice of proposed ulmanking relating to duy of disclosure, 56 Ft 8, 752 The notice was sto published in the Official Gastete. 1129 Office Gaz Pat. Off. 2, Okagust 72, 1991, Staty written commen-ter of the Office of Comments of the Office of Comments of Apulic hearing was belled on the hearing. The sixty wide-shot officers of the Office of Comments of the Assistant Commis-site of the Office of Comments of the Searing are varied to the Office of Comments of the Searing are varied for public learning to the Assistant Commicomments and a copy of the transcript of the hearing are available for public inspection in the Office of the Assistant Commissioner for Patents, Room 919, Crystal Park 11, 2121 Crystal Drive, Arlington, VA.

Familiarity with the notice of proposed rulemaking is assumed. Changes in the text of the rules published for comment in the notice of proposed rulemaking are discussed. Comments received in writing and at the public hearing in response to the notice of proposed rulemaking are discussed.

The rules as adopted shall take effect as to all applications and reexamination proceedings either pending or filed on or after the effective date of these rules. Thus, any information disclosure statement that is filed on or after that date must comply with the provisions of §§ 1.97 and 1.98 to be entitled to consideration.

Changes in Text: The final rules contain several changes to the text of the rules as proposed for comment. Those changes are discussed below

Section 1.17(i)(1) has been changed from the proposed text to reflect the recent increase in the amount of the fee for filing a

petition from \$120.00 to \$130.00. Section 1.56(a) has been clarified to indicate that the duty of an individual to disclose information is based on the knowledge of that individual that the information is material to patentability.

A sentence has been added to §1.56(a) to express the principle that the Office does not condone the granting of a patent on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated brough had faith or intentional misconduct. In addition, \$1.56(a) - proposed has been changed to indicate that if all information material to patentialitity of any claim issued in a patent is cited by the Office or submitted to the Office in the manner prescribed by §§1.47(h)-(d) and 1.98, the Office will consider as satisfied the

duty to disclose to the Office all information known to be material to patentiability, as contrasted to the broader dutt. of cardor and good faith. This rule does not attempt to define the spectrum of cornicate that would lack the candor and good faith in dealing with the Office which is expected of individuals who are associated with the filing or prosecution of a patent applica-

In \$1.56(t), the purse "or being made of record" life been inserted to make it clear that information is not material to patentability within the meaning of \$1.56 if it is cumulative to patentability within the meaning or § 1.50 it is cumulative to either information already of frecord in the application or contemporaneously being made of record by applicant. For example, there would be no benefit to the Office for applicant to submit to the Office of the Office of applicant to submit to the Office of the

me Ultice to different occuments naving the same teaching imply because the information attendance of the information attendance of the information attenda case of unpatentability, as set out in the preamble of the notice of proposed rulemaking, has been incorporated into the rule itself.

A prima facie case of unpatentability of a claim is established when the information compels a conclusion that the claim is

under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable

(2) giving each term in the claim its forascis reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

First standard conforms to it a standard used by an

This prima facie standard conforms to il. ; standard used by an examiner to determine whether a claim is prima facie

Section 1.56(b)(2) has been modified from the text of the proposed rule. The focus of this paragraph has been changed so that it now relates to information which either refutes, or is

istent with, a position that applicant takes in either opposing an argument of unpatentability relied on (1) by the Office, or

(2) asserting an argument of patentability. The change from the proposed rule makes clear that information is material when it either refutes, or is inconsistent with, a

is material when it either refutes, or is inconsistent with, a position taken by applicant before the Office. Section 1.97(e) has been changed from the proposed text to make it clear that a certification could contain either of two statements. One statement is that each item of information in an information disclosure statement was cited in a search report from a patent office outside the U.S. not more than three mo prior to the filing date of the statement. Under this certification. would not matter whether any individual with a duty actually knew about any of the information cited before receiving the scarch report. In the alternative, the certification could state that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual having a duty to disclose more than three months prior to the filing of the statement

The changes to the text of §1.97(e) as proposed place the appropriate priority on getting relevant information to the Office promptly, with minimum burden to applicant. The text of the proposal has also been changed by adding the phrase "after making reasonable inquiry" to make it clear that the individual making the certification has a duty to make reasonable inquiry regarding the facts that are being certified. For example, if an inventor gave a publication to the practitioner prosecuting an application with the intent that it be cited to the Office, the practitioner should inquire as to when that inventor became ware of the publication before submitting a certification under §1.97(e)(ii) to the Office.

A new paragraph (h) has been added to the text of proposed §1.97. The purpose of new paragraph (h) is to ensure that no one could construe the mere filing of an information disclosure statement as an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in §1.56(b). It is in the best interest of the Office and the public to permit and encourage in dividuals to cite information to the Office without fear of making an admission against



litigation when combined with information not known at the

ligation when combined with information not known at the time of the prosecution to any person substantively involved in the preparation or prosecution of the application. Reply: Paragraph (a) of \$1.50 makes it clear that the Office recognizes that the duty to disclose material information is limited to such information which is known by an individual issues to such automation where is shown by an andividual substantively involved in the preparation or prosecution of the application. Thus, while information may be material under the definition of §1.56(b)(1), there can be no duty to disclose the information if it is material only in combination with unknown Information

information.

Comment 30. One comment stated that proposed §1,56(b) should be modified so that paragraph (b)(1) refers to information that renders a claim unpatentable (Det for*), paragraph (b)(2) remains as proposed, and a paragraph (b)(3) is added to include definition of materially as "ine loosest information over which any pending claim patentably defines." This comment suggested that this modified definition over high the second has the saddless definition of the second has the saddless definition over the second second has the saddless definition over the second secon requiring the applicant to submit references which applicant knows are immaterial and to then engage in "straw man aceuments based on such references.

Reply: The suggested modification to \$1.56 has not been adopted. Repty: The suggested modification to 91.20 has not been adopted. The suggested flanguage would accentifyly require information to filled in each application, whether the information is rotevant or not, since the 'closest information' would be required. Section 1.56 does not require information which is not relevant to be submitted, but only information which meets the definition of material as set out in the rolle.

Comment 31. One comment stated that if proposed §1.56(b)(1) is promulgated, there would be no need for proposed §1.56(b)(2) ith regard to information which would make a prima facie cas with regard to information which would make a prima racte can of unpatentability and other information required by paragraph (b)(2) might be obscure. Another comment argued that par-graph (b)(2) was unnecessary, confusing and ambiguous and suggested changes in the language to make the requirement clear

and less ambiguous. Reply: The suggestion as to the language change to \$1.56(b)(2) has been adopted. The final rule language avoids the perceived problem of requiring an applicant to submit information support-ing a position taken by the examiner. It is not appropriate. however, to eliminate paragraph (b)(2) because it is an essential part of the definition of information material to patentability and will help to ensure that all material facts are brought to the attention of the examiner during the examination process. Comment 32. One comment questioned the language of proposed \$1.56(b)(2) as to how an applicant could consider a prior art reference as supporting a position of unpatentability taken by the Office while at the same time disputing that interpretation. Reply: The language of §1.56(b)(2) has been modified to clarify that information is material to patentability if it refutes, or is inconsistent with, a position the applicant takes in (1) opposing an argument of unpatentability relied on by the Office, or (2)

asserting an argument of patentability.

Comment 33. One comment stated that \$1.56(b)(2) was flawed in requiring a duty to conduct a file search to make sure that no information exists which even arguably contradicts a position taken or to be taken in response to the examiner, or which supports the examiner's position which may be improper.

Reply: Section 1.56(b)(2) does not require a search of files.

Under \$1,56(a), the duty of disclosure is confined to that information which is known to an individual to be material as defined

in paragraph (b). Comment 34. One comment stated that proposed §1.56(c) should be modified so that the duty of any individual designated as having a duty of disclosure would terminate when such indi vidual ceases to be substantively involved in the preparation or prosecution of the application. The comment used, as an example, an inventor who would not be aware of art cited by the examiner which would cause information known to the inventor to fall within the definition of materiality for the first time Reply: The suggestion in the comment is not adopted. The duty to disclose information material to patentability rests on the individuals designated in §1.56(c) until the application issues as a patent or becomes abandoned. Paragraph (a) of § 1.56 makes it clear, however, that each individual has a duty to disclose only information which is known to that individual to be material. Comment 35. One comment stated that proposed \$1.56(c)(3) should not include the assignee, or anyone to whom there is an obligation to assign the application, in the class of those who have a duty to disclose material information since there might be a "witch hunt" during litigation to find one employee with knowledge of, or possession of, information that should have been disclosed.

Reply: No modification to §1.56(c)(3) is needed since §1.56 sets forth that only individuals who are associated with the filing and prosecution of a patent application have a duty of candor and good faith, including a duty to disclose to the Office all informa-

tion known to be material to patentability.

Comment 36. One comment stated that proposed § 1.56(d) should be revised to expressly allow an inventor to satisfy the duty by disclosing information to the practitioner who prepares or pros-ecutes the application so that redundant information disclosure statements will not be required from both the inventor and the

attorney or agent. Reply: The suggestion in the comment is not adopted since the duty as described in § 1.56 will be met as long as the information in question was clted by the Office or submitted to the Office in the manner prescribed by §§1.97(b)-(d) and 1.98 before Issuance of the patent. Statements from both an inventor and the practitioner are not required to be submitted.

practioner are not required to submitted.

Comment 37. One comment stated that proposed §§1.52(c) and
1.67(c) should be modified to either (1) expressly permit alterations to be made in an application subsequent to the signing of
the oath or declaration if a supplemental oath or declaration is the own or occuration it a suppremental oath or occuration is faster submitted, or (2) more properly, prohibit such alterations since if alterations are desirable, they can be made and the application can be filed with an unsigned oath or declaration. Another comment stated that willfully filling out false oaths should never be condoned.

Reply: The Office does not condone willfully filling out false oaths. Further, §10.23(e)(11) indicates that the Office considers it misconduct for a practitioner to knowingly file or cause to be filed an application containing a material alteration made after the signing of an accompanying oath or declaration without identifying the alteration. The Office will not consider striking an application in which an alteration was made, but a supplemental oath or declaration is required to be filed in an application ining alterations made after the signing of the oath or

ument 38. One comment stated that the implementation of proposed §§1.63(b)(3) and 1.175(a)(7) allows for a two-month delay in the deadline for requiring declarations complying there-

Reply: The averments in oath or declaration forms presently in use that comply with the previous §1.63 or §1.175 will also comply with the requirements of the new rules. Therefore, the Office will continue to accept the old oath or declaration forms

as complying with the new rules.

Comment 39. Five comments questioned the need for the proposed rules since statistics show that information disclosure statements are submitted early in prosecution and questioned what new service is being provided for the proposed fee in § 1.97. Reply: The Office desires to continue to encourage Information to be submitted promptly so that it can be considered by the examiner when the first Office action is prepared. Some people have expressed a desire to have the option of waiting to submit information until after the first Office action, without concern that they will be subject to a charge of inequitable conduct. Section 1.97(c), as amended, will provide this option to applicants in that information will be considered later than three months after the filing date of the application (§1.97(a) prior to amendment) without a showing of promptness (prior § 1.99). The fee will compensate the Office for the added expense caused by the late submission of the information and will serve as a disincentive to the intentional withholding of information even for a short period of time.

Comment 40. Two comments suggested that proposed

§1.97(a) be modified so that the mechanism of proposed §1.98 would not be the only acceptable technique for submitting information

Reply: The Office has set forth the minimum requirements for information to be considered in §§ 1.97 and 1.98. These rules will provide certainty for the public of exactly what the requirements are, when the Office will consider information and when the Office will not consider information. Thus, applicants are provided with means for complying with the duty of disclosure by following the rules. If information is submitted in a manner so that it is not considered by the Office, applicant will assume the